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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/843,400 | 04/26/2001 | Takanori Nishimura | 450100-03182 | 3418 |
| 20999 | 7590 | 10/05/2005 | EXAMINER | |
| FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | ROHWER, JACOB P | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2624 | | |

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/843,400 | NISHIMURA, TAKANORI | |
| | Examiner | Art Unit | |
| | Jacob P. Rohwer | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 April 2001.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-38 is/are rejected.
 7) Claim(s) 19 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 26 April 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ✓ 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 ✓ 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Pg 25 Lin 16 #12. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 2 #9 and Fig 17 #358. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by

the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 11, 20, and 29 disclose "E-mail information not having a file attached thereto". The entire specification consistently discloses E-mail information with a file attached thereto and never discloses E-mail information without a file attached.

Claim 19 is objected to because of the following informalities: Line 17 states "opening the transfer in received". This is grammatically incorrect. Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Accommodating Capability Verification in a Data Communication Network.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-18, 22-27, and 31-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. In claims 11, 20, and 29, of which claims 13-18, 22-27, and 31-36 are all respectively directly dependent or indirectly dependent, there is claimed subject matter stating "E-mail information not having a file attached thereto". Claims 15-18, 24-27, and 33-36 expressly claim an E-mail with a file attached to it. This claimed subject matter contradicts itself in regard to the dependency on claims 11, 20, and 29. Furthermore, claims 13-14, 22-23, and 31-32 claims "file information", which examiner assumes to mean a file attachment to an E-mail. Again, this claimed subject matter contradicts itself in regard to the dependency on claims 11, 20, and 29.

Claims 16, 25, and 34 all recite the limitation "said attached file information" in Line 4. There is insufficient antecedent basis for this limitation in the claim.

As a result of the claim language being indefinite and failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, Examiner will make art rejections assuming applicant meant to claim an E-mail with an file attached thereto as disclosed repeatedly in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6, 10, 19, 28, 37, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No 6,775,705 to Maeda.

Regarding claim 1, Maeda discloses an information processing apparatus for transmitting the information to be transferred to a reception terminal (**Fig 1**), comprising:

accommodating capability verifying means (**Fig 1 #10**) for verifying the information accommodating capability in said reception terminal or in a communication system encompassing said reception terminal, based on the destination information in sending the transfer information to said reception terminal; (**Col 3 Lin 15-18**)

information converting means (**Fig 1 #7, Col 7 Lin 46-50**) for converting the transfer information to be transmitted in meeting with the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal if the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal is not matched to said transfer information to be transmitted; (**Col 2 Lin 58-60, Lin 64-67 Col 3 Lin 2**) and

transmission means for transmitting said transfer information (**Fig 1 #4, #8, #12**).

Regarding claim 2, Maeda further discloses the information processing apparatus according to claim 1 wherein the E-mail information is sent as said transfer information to said reception terminal (**Fig 1 #3**).

Regarding claim 6, Maeda further discloses the information processing apparatus according to claim 2 wherein the file information attached to said E-mail is an image file. (**Col 1 Lin 58**)

Regarding claim 10, please see rejection of claim 1. Additionally, the apparatus of claim 1 performs the method of claim 10.

Regarding claim 19, please see rejection of claim 1. Additionally, Maeda further discloses a reception terminal (**Fig 1 #2**) including reception means (**Fig 1 #5**) for receiving said transfer information sent from said transmission terminal and information opening means for open the transfer information. (**Fig 1 #12**)

Regarding claim 28, please see rejection of claim 19. Additionally, the system of claim 19 performs the method of claim 28.

Regarding claim 37, please see rational provided in the rejection of claims 1 and 10. The apparatus of claim 1 and the method of claim 10 correspond to the medium for causing an information process apparatus to execute a program of claim 37. (**Col 4 Lin 32-34**)

Regarding claim 38, please see rational provided in the rejection of claims 19 and 28. The apparatus of claim 19 and the method of claim 38 correspond to the medium for causing an information process apparatus to execute a program of claim 38. (**Col 4 Lin 32-34**)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda as specified in claim 1 above.

Regarding claim 3, Maeda discloses the information processing apparatus according to claim 2 wherein said accommodating capability verifying means verifies the information accommodating capability of said reception terminal based on a domain name of an E-mail address as said destination information and/or on a previously provided information accommodating capability of a reception terminal or a system encompassing said reception terminal. (**Fig 1 #11, Col 3 Lin 20-25 The system provides a storing unit for storing accommodating capabilities of different destination apparatuses.)**

Maeda does not expressly disclose that the information accommodating capability of a reception terminal or a system encompassing said reception terminal is stored or accessed through a table format.

However, it is well known in the art that when information is stored, a common format is that of table.

It would have been obvious for one of ordinary skill in the art to use the table format well known in the art in order to store information accommodating capability of a reception terminal or multiple reception terminals.

The motivation for doing so would have been an efficient way of organizing the information accommodating capability parameters unique to each reception terminal, especially when multiple reception terminals' capabilities are stored as disclosed in Maeda.

Therefore, it would have been obvious to combine the well-known table format with the storing of the information accommodating capability in Maeda in order to obtain the invention of claim 3.

Claims 4, 5, 7, 11-16, 20-25, and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda as specified in claim 1 above, in view of US Patent No 6,775,688 to Kakimoto.

Regarding claim 5, Maeda discloses the information processing apparatus according to claim 4.

Maeda does not expressly disclose that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the file information, said information converting means states the accessing information to means for saving said file information in said E-mail as a method enabling the confirmation of the contents of said file information.

However, Kakimoto discloses an information processing apparatus (**Fig 1**) that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the file information, said information converting means states the accessing information to means for saving said file information in said E-mail as a method enabling the confirmation of the contents of said file information. (**Col 2 Lin 27-33, a link to a network where the specified data is stored is distributed to the desired destinations.**)

The Maeda Patent and the Kakimoto Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the Maeda Patent in order to obtain the invention in claim 5.

Regarding claim 4, please see rejection of claims 1 and 5. Kakimoto discloses that by clicking on a link sent to the reception terminal, distributed data can be accessed when the information accommodating capability is not conducive to the data sent. This would be considered a method enabling a user of said reception terminal to confirm the contents of said file information.

Regarding claim 7, Maeda discloses the information processing apparatus according to claim 2 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes the format of the information of the attached file. (**Col 1 Lin 42-46 mention changing image formats and Col 9 Lin 8-10 mentions different image formats**)

Maeda does not expressly disclose the information processing apparatus according to claim 2 wherein the information accommodating capability of said reception

terminal or said communication system encompassing said reception terminal includes the maximum size of the E-mail and the maximum file size of the file information.

However, Kakimoto discloses an information processing apparatus wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes the maximum size of the E-mail (**Col 1 Lin 16-17**) and the maximum file size of the file information. (**Col 2 Lin 36-37**)

There is disclosed a determination means in which the size of the specified data is determined to be smaller or larger than a predetermined size capability of the destination.

The Maeda Patent and the Kakimoto Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the maximum size of the E-mail and the maximum file size of the attachment as specified in the Kakimoto Patent in order to determine the information accommodating capability of the reception terminal as specified in the Maeda Patent.

The suggestion/motivation for doing so would have been to avoid excessive load on the network because a large size of data is transmitted and can't be accommodated. (**Col 1 Lin 24-27**)

Therefore it would have been obvious to combine the Kakimoto Patent with the Maeda Patent in order to obtain the invention in claim 7.

Regarding claim 11, Kakimoto further discloses the information processing method according to claim 10 wherein the E-mail information not having a file attached

thereto is sent as said transfer information to said reception terminal. (**Reference discloses data distribution through E-mail (Col 1 Lin 15-16) and then discloses accessing distributed data through a network, through an E-mail attachment, or as real data (Col 2 Lin 27-37). Real data in this regard embodies the main text of the E-mail.)**

Regarding claim 12, which depends from claim 11, please see rejections of claims 3 and 11 above. Additionally the apparatus of claim 3 performs the method of claim 12.

Regarding claim 13, which depends from claim 11, please see rejection of claim 4 above. Additionally the apparatus of claim 4 performs the method of claim 13.

Regarding claim 14, which depends from claim 13, please see rejection of claim 5 above. Additionally the apparatus of claim 5 performs the method of claim 14.

Regarding claim 15, which depends from claim 11, please see rejection of claim 6 above. Additionally the apparatus of claim 6 performs the method of claim 15.

Regarding claim 16, which depends from claim 11, please see rejection of claim 7 above. Additionally the apparatus of claim 7 performs the method of claim 16.

Regarding claim 20, which depends from claim 19, please see rejections of claim 11 above. Additionally the system of claim 20 performs the method of claim 11.

Regarding claim 21, which depends from claim 20, please see rejections of claims 3 and 11 above.

Regarding claim 22, which depends from claim 20, please see rejection of claim 4 above.

Regarding claim 23, which depends from claim 22, please see rejection of claim 5 above.

Regarding claim 24, which depends from claim 20, please see rejection of claim 6 above.

Regarding claim 25, which depends from claim 20, please see rejection of claim 7 above.

Regarding claim 29, which depends from claim 28, please see rejection of claims 1 and 11 above. Additionally the apparatus of claim 1 performs the method of claim 29.

Regarding claim 30, which depends from claim 29, please see rejection of claims 3 and 11 above. Additionally the apparatus of claim 3 performs the method of claim 30.

Regarding claim 31, which depends from claim 29, please see rejection of claim 4 above. Additionally the apparatus of claim 4 performs the method of claim 31.

Regarding claim 32, which depends from claim 29, please see rejection of claim 5 above. Additionally the apparatus of claim 5 performs the method of claim 32.

Regarding claim 33, which depends from claim 29, please see rejection of claim 6 above. Additionally the apparatus of claim 6 performs the method of claim 33.

Regarding claim 34, which depends from claim 29, please see rejection of claim 7 above. Additionally the apparatus of claim 7 performs the method of claim 34.

Claims 8, 17, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Maeda and Kakimoto as specified in claim 7 above, in view of US Patent No 6,457,044 to IwaZaki, and further in view of US Patent No 6,421,429 to Merritt et al.

Regarding claim 8, the combination of Maeda and Kakimoto as specified in claim 7 above discloses the information processing apparatus according to claim 6 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes the maximum size of the E-mail, the image format of the attached image file, the maximum file size of the file information.

The combination does not expressly disclose that the information accommodating capability includes the maximum pixel size of the image corresponding to said image file.

However, IwaZaki discloses an image processing apparatus that determines information accommodating capability of a reception terminal including the maximum pixel size of the image corresponding to said image file. (**Col 5 Lin 50-51 mentions the resolution of the image)**

The Combination of Maeda and Kakimoto and the IwaZaki Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the resolution of the attached image as specified in the IwaZaki Patent in order to determine the information accommodating capability of the reception terminal as specified in the combination of Maeda and Kakimoto.

The suggestion/motivation for doing so would have been to quickly start and efficiently perform image transmission and avoid time lost when data transmission is not compatible between the transmitting and receiving terminals. (**Col 3 Lin 18-20**)

Furthermore, the combination does not expressly disclose that the information accommodating capability includes the maximum number of colors of the image corresponding to said image file.

However Merritt discloses an image processing apparatus that determines information accommodating capability of a reception terminal including the maximum number of colors of the image corresponding to said image file. (**Col 10 Lin 35-39**)

The Combination of Maeda and Kakimoto and the Merritt Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the maximum number of colors of the image corresponding to the image file as specified in the Merritt Patent in order to determine the information accommodating capability of the reception terminal as specified in the combination of Maeda and Kakimoto.

The suggestion/motivation for doing so would have been to allow for correct image processing with respect to colors in the transmission of the image data from a transmitting to a receiving terminal.

Therefore it would have been obvious to combine the IwaZaki and Merritt Patents with the combination of Maeda and Kakimoto in order to obtain the invention in claim 8.

Regarding claim 17, which depends from claim 15, please see rejection of claims 8 and 11 above. Additionally the apparatus of claim 8 performs the method of claim 17.

Regarding claim 26, which depends from claim 24, please see rejection of claim 8 and 11 above.

Regarding claim 35, which depends from claim 33, please see rejection of claims 8 and 11 above. Additionally the apparatus of claim 8 performs the method of claim 35.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda as specified in claim 1 above, in view of US Patent Publication No 2001/0039615 to Bowker et al.

Regarding claim 9, Maeda discloses the information processing apparatus according to claim 6.

Maeda does not expressly disclose the information processing apparatus according to claim 6 wherein, if said image file is a moving image file and the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal corresponds only to a still image file, said information converting means renders one or plural frames making up said moving image file into the file information attached to said E-mail.

However, Bowker discloses a data transmission apparatus that translates video to still images when a specific data processing terminal can't accommodate the data format transmitted. (**Para [0001] and Para [0006] Lin 1-10**)

The combination of the Bowker Publication and the Maeda Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to translate video to still images as specified in the Bowker Publication in order to convert the image file to be transmitted as specified in the Maeda Patent.

The suggestion/motivation for doing so would have been to allow for the user of the reception terminal to view the image file when the accommodating capability of the terminal does not allow them to view a video or motion image file.

Therefore it would have been obvious to combine Bowker Publication with the Maeda Patent in order to obtain the invention in claim 9.

Claims 18, 27, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Maeda and Kakimoto as specified in claims 1 and 11 above, in view Bowker et al.

Regarding claim 18, which depends from claim 15, please see rejection of claims 9 and 11 above. Additionally the apparatus of claim 9 performs the method of claim 18.

Regarding claim 27, which depends from claim 24, please see rejection of claims 9 and 11 above.

Regarding claim 36, which depends from claim 33, please see rejection of claims 9 and 11 above. Additionally the apparatus of claim 9 performs the method of claim 36.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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